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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,803	07/14/2003	Linda Najdek	98.22US-CON	5789
7590 Estee Lauder Companies 125 Pinelawn Road Melville, NY 11747			EXAMINER WEBMAN, EDWARD J	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,803

Applicant(s)

NAJDEK ET AL.

Examiner

Edward J. Webman

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/5/07</u> | 6) <input type="checkbox"/> Other: _____ |

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,649,174. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant independent claims encompass the patent claim regarding the film forming agent and ratio.

Applicants stipulate that the rejection remains in effect until such time as they amend or file a TD.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2, 4-9, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Touzan et al in view of Shah et al. Claim 9 is included here; it was inadvertently admitted in the first action on the merits.

Touzan et al teach a two phase composition for cleansing containing a demixing agent (title, abstract). An aqueous and separate oily phase in a ratio of 30:70-60:40 is disclosed (abstract). Isohexadecane, liquid paraffins, and silicone oils including cyclopentadimethylsiloxane are disclosed (column 4 lines 1-20). Colorants are specified (column 4 line 25).

Shah et al teach a polyvinylpyrrolidone/vinyl acetate copolymer at 1-5% to maintain pigments in suspension (column 4 lines 37-57). Applicants disclose this polymer on page 2 line 33.

It would have been obvious to one of ordinary skill to add a polyvinylpyrrolidone/vinyl acetate copolymer to the composition of Touzan et al for the beneficial effect of maintaining colorants in suspension in view of Shah et al.

Applicants argue that one of ordinary skill would not add PVP to the composition of Touzan et al as a suspension agent because only a mere 0.05% colorant is disclosed, compared to the large amounts of colorant in Shah et al. The implication is that PVP is only effective for large amounts of colorant. However, this is mere speculation. Applicants also argue that

demixing compositions are difficult to make, therefore, one of ordinary skill would not add PVP, a known suspension and emulsion stabilizer, because it would interfere with the demixing function. However, Touzan et al already use emulsifying agents, namely the many surfactants cited at column 2 line 36 et seq. That is, one of ordinary skill, reading that Touzan et al, is already using such agents, it argued, would be motivated to accommodate the addition of another, such as PVP. Applicants argue that Shah et al disclose cationic film-formers. However, they appear to be non-ionic (column 3 lines 35-32). However, their nature is irrelevant because the obvious combination concerns a suspension agent.

Claims 1, 2, 4-9, 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy et al in view of Grollier et al.

Nagy et al teach a makeup removing composition comprising two phases and a demixing agent (abstract). A 30:70-70:30 ratio of oil to aqueous phase is disclosed (column 3 lines 12-14). Mixtures of cyclic silicones, dimethicone and a volatile C16 paraffin are specified (column 4 lines 33-53).

Grollier et al teach two phase compositions comprising a cationic polymer for skin conditioning (abstract). Vinyl pyrrolidone-acrylamide copolymers are specified at 0.2-50% (column 8 lines 1-26, column 9 lines 20-24). Dimethylaminoethylmethacrylate is disclosed (column 8 line 59). Applicants disclose PVP/dimethylamino ethyl-methacrylate on page 2 line 32.

It would have been obvious to one of ordinary skill to add a vinyl pyrrolidone-acrylamide copolymer to the composition of Nagy et al to achieve the beneficial effect of a skin conditioner in view of Grollier et al.

Applicants make the same argument here as in their response to the first 103, regarding the difficulty of making demixing compositions. However, here, Nagy et al teach hair conditioners (column 4 line 9). The cited Grollier et al polymers are such compounds. Thus, it is argued, one of ordinary skill, reading Nagy et al, would be motivated to accommodate the addition of the Grollier et al polymers. Applicants also argue that Nagy et al teach demixing agents in the aqueous phase. However, the motivation to combine concerns a skin conditioning agent, not a demixing agent. Applicants also argue that Grollier et al teach against addition to the oil phase. However, Grollier et al is referring to anhydrous compositions. Further, it is argued, that the obvious composition will possess the claimed property because it is the same as that claimed. Applicants argue that they limit claim 8 to non-cationic polymers. However, applicants' specification is silent as to the nature of the polymers in paragraph 8 of the specification. Although Grollier et al characterize their polymers as cationic, it appears, without more, that applicants characterize similar polymers disclosed in paragraph 8 as non-ionic.

No claims allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 571-272-0633. The examiner can normally be reached on M-F from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Richter, can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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